

DETAILED ACTION

1. This action is in response to amendment filed on 12/30/2009. Claim 21 has been canceled. Claims 1-20 and 22 are presented for examination.
2. The 101 rejection to claims 1-13 and 22 are withdrawn in view of the amendment, however, 35 U.S.C. 101 rejection to claims 14-20 are maintained.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 14-20 recite computer readable medium, which include infrared, transport, propagate, and paper based on Specification on pages 54-55. Those media are not believed to enable the functionality to be realized with the computer. Therefore, claims 14-20 are non-statutory under 35 U.S.C. 101. Please see MPEP § 2106.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set

forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al, (US 2004/0128356), hereinafter Bernstein, in view of Beyda (US 2003/0229670), Szeto et al, (US 7,406,501), hereinafter Szeto.
7. As to claims 1, 9 and 10, Bernstein discloses the invention as claimed, including method comprising the steps of:
 - determining, with an *instant messaging* (IM enhanced email) and utilizing a processor that is executing the *instant messaging*, an Internet presence of a contact identified in an email message (page 2, 0016-0017, "presence detection by sending...email invitation"; page 1, 0007, "particular user's presence online...presence detection") in response to displaying the email message to a user, wherein the determining comprises comparing an email address of the contract identified to an address book database (page 7, 00124-0131, "compares the source of the email against...list of acceptable senders") at the time that the email message is displayed to the user; and
 - initiating, by utilizing the processor that is executing the *instant messaging* (instant messaging application) an instant messaging (IM) chat session with the contact in response to determining that the contact is present (page 1, 0007; page 4, 0064, "each recipient is sent an instant message invitation email message").

8. Although Bernstein discloses determining an internet presence of a contact using the IM enhanced email (page 2, 0017-0018), Bernstein does not specifically use terms instant messaging client. Beyda discloses instant messaging client (120, fig. 6; page 2, 0022, "user's online presence may still be detected or monitored by an instant messaging system"; 0029, "instant messaging server, service or system and thereby capable of detecting or monitoring the online presence"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Beyda because Beyda's teaching would allow a user to be notified of the presence of the intended recipient, as taught by Beyda (page 1, 0004-0005).

9. Bernstein does not specifically disclose retrieving an instant messaging address of the contact identified from the address book databases, and then using the retrieved instant messaging address to determine that the contact is present. Szeto discloses retrieving an instant messaging address of the contact identified (402, fig. 4) from the address book databases (400, fig. 4) (co. 10, lines 4-62), and then using the retrieved instant messaging address to determine that the contact is present (204, 206, fig. 2; 312, fig. 3; col. 7, lines 16-39). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Szeto because Szeto's teaching would provide an accurate indication of whether the retrieved instant messaging address is currently online or offline, as taught by Szeto (col. 7, lines 16-39).

10. As to claims 2-8, Bernstein discloses, wherein the step of initiating the IM chat session comprises the steps of: generating an IM chat window; obtaining information from the email message; and displaying the obtained information in the generated IM chat window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user").

11. As to claims 11-13, they are rejected for the same reasons set forth in claims 2-8 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

12. As to claim 14, it is rejected for the same reasons set forth in claim 1 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

13. As to claims 15-19 and 22, they are rejected for the same reasons set forth in claims 1-8 above. In addition, Bernstein discloses computer-readable code (page 3, 0052-0053).

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al, (US 2004/0128356), hereinafter Bernstein, in view of Beyda (US 2003/0229670), Szeto et al, (US 7,406,501), hereinafter Szeto, further in view of Dalal et al, (US 2002/0065894), hereinafter Dalal.

15. Bernstein discloses displaying the obtained information in the generated IM chat window (page 2, 0023, "IM area"; page 5, 0093-0100, "display to the user"). However,

Bernstein does not specifically disclose providing the body of the email message as an IM chat message. Dalal discloses providing the body of the email message as an IM chat message (page 3, 0024, "the body of the email reply becomes the text content of the instant messaging"). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Bernstein and Dalal because Dalal's teaching would reduce the time to generate an instant message which has correlation information with the email message, as taught by Dalal (page 3, 0024).

16. Applicant's arguments filed on 12/30/2009 have been fully considered but they are not persuasive:

(1) Applicant asserts that Bernstein, Beyda, Szeto and Dalal fail to disclose, suggest, or render obvious determining, with an instant messaging client, an Internet presence of a contact identified in an email message in response to displaying the email message to a user, wherein the determining comprises comparing an email address of the contact identified to an address book database and retrieving an instant messaging address of the contact identified from the address book database and then using the retrieved instant messaging address to determine that the contact is present at the time that the email message is displayed to the user. In fact, at least Bernstein specifically teaches against such a claimed arrangement.

The examiner respectfully disagrees. Applicant fails to consider Bernstein's teaching. Bernstein explicitly discloses using an IM-enhanced email, a sender sends an

email to a recipient to determine the recipient's presence detection. When the sender receives a response email from the recipient and displays the received email to read, they can begin a conversation (page 2, 0017-0021). Bernstein discloses determining the contact (recipient) is present at the time the user (sender) displaying the email message, which is received from the recipient.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JUNGWON CHANG** whose telephone number is (571)272-3960. The examiner can normally be reached on M-F 6:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

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/JUNGWON CHANG/
Primary Examiner, Art Unit 2454
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